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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,047

07/15/2005

Emiko Kawata

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52835

7590

12/21/2010

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/518,047	<b>Applicant(s)</b> KAWATA ET AL.	
	<b>Examiner</b> JYOTHSNA A. VENKAT	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/31/10 has been entered.

Receipt is acknowledged of amendment and remarks filed on 8/31/10. Claims 7-10 have been added as per applicants' amendment dated 8/31/10.

Newly submitted claims 8-10 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: newly submitted claims 8-10 are drawn to method (group II) and the claims originally presented are drawn to compositions. Thus claims 1-3 and 7 are drawn to product (group I) and newly claims 8-10 are drawn to method of use (group II).

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process for using the product as claimed can be practiced with another materially different product such as the product of U. S. Patent 5,472,697.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

Art Unit: 1619

on the merits. Accordingly, claims 8-10 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### **Status of claims**

**Claims 4-6 are cancelled.** Claims 8-10 are withdrawn from consideration as being drawn to non-elected invention. Claims 1-3 and 7 are examined in the application.

### **Claim Rejections - 35 USC § 112**

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is new matter rejection.

There is lack of written description for claim 7, wherein the a first agent composition for permanent wave agent or for a hair straightening agent, wherein the first agent composition does not contain a polymer of dimethyl diallyl ammonium chloride and a copolymer of dimethyl diallyl ammonium chloride and acrylamide.

Applicants' in the response dated 8/31/10 point out support to pages 15-16 and tables 1 tables 1-4.

Tables 1-2 are drawn to permanent waving compositions and **not to straightener compositions**. Tables 1-2 are drawn to compositions using species under anionic surfactant, species under higher alcohol, and species under anionic polymer and species under reducing agent. These examples do not have cationic polymer. The comparative examples use two cationic polymers and these are Merquat 550 and Merquat 100.

Art Unit: 1619

Description for species under examples 1-7 which does not have cationic polymer does **not support the generic concept of claim 1 and claim 7**. Additionally examples 1-4 is not same as comparative example 1-4 with respect to ingredient (debrominated cetanol). The weight percentages do not match. The same is true for behenyl alcohol. The compositions under examples 1-7 are to permanent wave. Permanent wave compositions are for curling the hair; where as straightening compositions are for straightening the hair. There are no straightening compositions which excludes the cationic polymer.

Claims 1-3 and 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "type" (under 1(a)) renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "type"), thereby rendering the scope of the claim(s) unascertainable.

### **Claim Rejections - 35 USC § 103**

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000-264,821 (JP translated text).

JP teaches compositions for permanent wave or compositions for straightening curly hair. JP at paragraphs [0023-0025] teaches claimed anionic surfactant and see especially N-myristoyl methyl N-taurine sodium, where in X is NR and R is sodium, and see also another anionic surfactant before that which has taurine. JP at paragraphs [0026-0027] teaches claimed anionic polymer and the weight percent claimed for anionic polymer is 0.01-5% and this is

Art Unit: 1619

within the weight percent claimed (claim 2). JP at paragraphs [0029-0030] teaches claimed higher alcohol. The weight percent for anionic surfactant is 0.1-5 % and the weight percent for higher alcohol is 0.1-20%. When the higher weight percent of surfactant and lower weight percent of higher alcohol is added this weight percent is within the combined amount of (a) and (b) and the weight percent also meets the molar ratio. JP at paragraphs [0014-0017] teaches reducing agent claimed and at [0016] teaches the amount of reducing agent, which is 1-15% (claim 3). JP teaches anionic surfactant in the second agent, where as instant application is claiming anionic surfactant in the first agent. However, JP teaches all the components claimed for permanent waving or straightening the hair.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of JP by using anionic surfactant, higher alcohol, anionic polymer, reducing agent and apply it on hair. One of ordinary skill in the hair care art would be motivated to use the compositions on hair with the reasonable expectation of success that the hair was extremely smooth o touch when it was dry and also when wet. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1619

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1619